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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,021	09/05/2003	Makarand P. Gore	200312226-1	8140

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HEWLETT PACKARD COMPANY
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,021

Applicant(s)

GORE, MAKARAND P.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and (17-19 for the record only) is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Papers filed on 13 April 2005.

I. Applicant elects the invention of claims 1-5 (now 2-5) being acknowledged.

Applicant urges that the invention of claims 17-19 is so related to claim 2. It is reasonable. Therefore, the related claims 17-19 as urged will be allowed to be rejoined with claim 2 when it is found to be allowable only. Accordingly, no consideration of claims 17-19 is made on the record.

II. Claims 2, 4-5 and (17-19 for the record only) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 36 and 40-42 (allowed on 12 April 2005) of copending Application No. 10/351,188. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specific phthalocyanine and naphthalocyanine chromophore antennas in the instant claims are not patentably distinct from the phthalocyanine and naphthalocyanine dye antennas (being specified as "a radiation absorbing compound such as a dye" in the specification on page 4, line 4 in application Serial No. 10/351,188) as those in the applied claim 5.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant states on the record that a terminal disclaimer be filed when application Serial No. 10/351,188 is issued in to a patent.

The record shows that:

- Notice of Allowance mailed on 12 April 2005.
- Issued fee paid on 08 July 2005.

III. Claim 3 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 36 and 40 of copending Application No. 10/315,188 in view of Azuma (6,815,679).

The applied claims are related to a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix.

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The applied claims do not include “silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)” as that in the instant claim 3. Azuma at col.18:55-56 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Azuma.

This is a provisional obviousness-type double patenting rejection.

Applicant states on the record that a terminal disclaimer be filed when application Serial No. 10/351,188 is issued in to a patent.

The record shows that:

- Notice of Allowance mailed on 12 April 2005.
- Issued fee paid on 08 July 2005.

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IV. Claim 3 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 36 and 40 of copending Application No. 10/315,188 in view of Jones et al (6,682,810).

The applied claims are related to a direct light image composition comprising a matrix, an antenna, color former and an activator. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix.

The applied claims do not include “silicone 2,3 naphthalocyanine bis(trihexalsilyoxide)” as that in the instant claim 3. Jones et al at col.8:23-24 is cited to show the known use of silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) as a radiation absorbing compound as that in the instant claim.

Since the above references are all related to the selection and use of radiation absorbing compounds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to known silicone 2,3 naphthalocyanine bis(trihexalsilyoxide) for a reasonable expectation of absorbing radiation energy as disclosed and taught in Jones et al.

This is a provisional obviousness-type double patenting rejection.

Applicant states on the record that a terminal disclaimer be filed.

V. Claims 2, 4-5 and (17-19 for the record) are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by Gore et al (Application Serial No. 10/351,188).

Gore et al disclose and teach a direct light image composition comprising a matrix, an antenna, color former and an activator. The chemical ingredients are read on those in the instant claims. The antenna is dissolved in the matrix. One of the activator or the color former is soluble in the matrix at ambient condition. The soluble of the activator and the color former is dissolved in the matrix. The other of the activator and the color former is substantially uniformly distributed in the matrix. The antenna has the property of absorbing laser and infrared radiations. Please see the whole disclosure of the applied application, especially at claims 1, 5-7, 36 and 40-42.

Since Gore et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Gore et al.

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Applicant's arguments filed 06 September 2005 have been fully considered but they are not persuasive.

In accordance to the record that applicant and the counsel for Hewlett-Packard Company provide that any feature or aspect of the presently claimed invention is disclosed but not claimed in copending applicants Serial No. 10/351,188 was derived from the inventor of the applicant.

It is first of all. It must determine the scope of the instant claims then excluded them and/or the like from those in the copending application on the record.

Secondly, the inventions in the applications are not substantially identical in scope of the claimed limitations as required by law. Applicant and/or the counsel for Hewlett-Packard Company would have a chance to convincingly provide an issue with respect the scope of each of the embodiments in the claims being identical and obvious as claimed and urged on the record. What is each of the obviousness and distinction embodiments being filed in the instant application and its claims from each of those in application Serial No. 10/351,188 and its claims to an authority.

It is insufficient and improper since MPEP 2136.05 requires an antedating filing date or applicant's own work but not "any feature or aspect of the presently

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claimed invention is disclosed but not claimed in copending applicants Serial No. 10/351,188”.

It is not correct since at least claims 35 of application Serial No 10/351,188 is substantially identical in scope of the claimed 17 limitations in the instant application.

VI. Applicant’s declaration under Rule 132 filed on 06 September 2005 with the counsel for Hewlett-Packard Company’ support filed on the record has been fully considered but are not found to be convincing.

For “any feature or aspect of the presently claimed invention is disclosed but not claimed in copending applicants Serial No. 10/351,188 was derived from the inventor of the applicant”,

(1) it is not correct since at least claims 35 of application Serial No 10/351,188 is substantially identical in scope of the claimed 17 limitations in the instant application (. Accordingly, at least claim 35 should not be in application Serial No 10/351,188 must be not be deleted) and,

(2) it is insufficient and improper since MPEP 2136.05 requires an antedating filing date or applicant’s own work but not “any feature or aspect of the

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presently claimed invention is disclosed but not claimed in copending applicants
Serial No. 10/351,188”.

VII. The declaration under Rule 130 filed on 06 September 2005 with respect
same assignment of the instant application and application Serial No. 10/351,188 is
found to be convincing. Accordingly, the rejections under 35 USC 103 are
withdrawn.

VIII. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE**
MONTHS from the mailing date of this action. In the event a first reply is filed within **TWO**
MONTHS of the mailing date of this final action and the advisory action is not mailed until after
the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing
date of this final action.

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IX. The non-elected inventions of claims 6-16 are permitted to be rejoined with claims 2-5 when claims 2-5 are allowable provided that claims 6-16 must contain all of the limitations of at least claim 2.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-1332. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
25 October 2005

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Hoa Van Le".